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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,584

02/04/2005

Patrick Dupont

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7590 02/08/2007
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EXAMINER

LUONG, VINH

ART UNIT

PAPER NUMBER

3682

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/523,584	DUPONT ET AL.	
	Examiner	Art Unit	
	Vinh T. Luong	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/4/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> . |

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1. The preliminary amendment filed on February 4, 2005 has been entered.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the implied phrase "[t]he invention device is directed to." Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. For example:

(a) The use of the arrows instead of the lead lines from reference character such as 16 in Fig. 3 is improper since Applicant's arrow is not used to indicate the entire cross section, the surface, or the direction of movement. See 37 CFR 1.84(r);

(b) The various parts in Fig. 3 should be embraced by a bracket in order to show their relationship. 37 CFR 1.84(h)(1);

(c) Every line, number, and letter must be durable, clean, black (except for color drawings) sufficiently dense and dark, and uniformly thick and well defined as required by 37 CFR 1.84(l). See, e.g., in Fig. 1, the reference numbers 14, 16P, and 16 are thicker than other numbers; and

(d) Each part of the invention such as the fixed support in claim 9, the wire wound into a spiral with contiguous turns in claim 12, the control mechanism, the opening leaf of the

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motor vehicle, and the side door of the vehicle in claim 13 should be designated by a reference character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as the fixed support in claim 9, the wire wound into a spiral with contiguous turns in claim 12, the control mechanism, the opening leaf of the motor vehicle, and the side door of the vehicle in claim 13 must be shown or the features canceled from the claims. *No new matter should be entered.*

6. The use of the trademark such as ZAMAK has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

8. The disclosure is objected to because of the informalities, e.g., listed below:

- (a) The specification should have appropriate headings listed above; and
- (b) Each part of the invention such as the fixed support in claim 9, the wire wound into a spiral with contiguous turns in claim 12, the control mechanism, the opening leaf of the

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motor vehicle, and the side door of the vehicle in claim 13 should be designated by a reference character.

Appropriate correction is required.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims: (a) the jacket 18 being formed by at least one wire, particularly a metal wire wound into a spiral with contiguous turns in claim 12; and (b) the module 10 forming a control mechanism arranged in an opening leaf of the motor vehicle, particularly a side door of the vehicle in claim 13. However, the drawings do not show: (a) the wire wound into a spiral with contiguous turns; and (b) the control mechanism arranged in the opening leaf of the motor vehicle, particularly the side door of the vehicle. It is unclear as to how Applicant forms: (a) the jacket as claimed in claim 12; and (b) the control mechanism as claimed in claim 13.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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12. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the recitation “this” in claims 1, 8, and 11 should have been changed to “the” and the recitation “taken together” in claims 8 and 11 should be deleted.

It is unclear whether a confusing variety of terms such as “a Bowden-type cable” and “a cable” in claim 1 refer to the same or different things. See MPEP 608-01(o) and double inclusion in MPEP 2173.05(o).

The term such as “fusible” in claims 4-9 is vague and indefinite in the sense that things which may be done are not required to be done. For example, the ribs 32, 34 are fusible but are not structurally required to be fused. See “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “crimpable” in *Application of Collier*, 158 USPQ 266 (CCPA 1968), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is

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followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation "the fusible ribs of the first retaining element," and the claim also recites "*preferably* extending longitudinally," which is the narrower statement of the range/limitation. Similarly, claim 12 recites the broad recitation "at least one wire" and the claim also recites "*particularly* a metal wire," which is the narrower statement of the range/limitation. In addition, claim 13 recites the broad recitation "an opening leaf of a motor vehicle" and the claim also recites "*particularly* a side door of the vehicle," which is the narrower statement of the range/limitation.

Claim 10 is indefinite since claim 10 is dependent upon itself.

The use of alternative expression "or, at the very least" in claim 8 renders said claim vague and indefinite.

No antecedent basis is seen for the term "it" in claim 9.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Michel (FR 2 730 772 cited as reference X in Applicant's corresponding PCT Application).

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Regarding claim 1, Michel teaches a control device for a module (unnumbered, shown by dashed line in Fig. 2. See Attachment hereinafter "Att.") forming a lock mechanism, of the type comprising a Bowden-type cable containing a cable 6 having two ends, a proximal end (Att.) and a distal end respectively, the cable 6 being housed in a jacket 8 having two ends, a proximal end (8P in Att.) and a distal end (8D in Att.) respectively, which are immobilized by two proximal 1 (Fig. 1) and distal (see Fig. 2 in Att.) retaining elements, characterized in that at least a first end (8P in Att.) of the jacket 8 is connected to a corresponding first retaining element 2 (Figs. 5 and 7) by means of a connecting element 1 attached to the first end of the jacket 8.

Regarding claim 2, the connecting element 1 is overmolded or capable of being overmolded on the first end of the jacket 8 as seen in Figs. 1 and 8. On the other hand, note that the determination of patentability is based on the product itself, not by its method of production. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006), and MPEP 2113.

Regarding claim 3, the connecting element 1 is capable of being ultrasonically welded to the first retaining element 2. Note that the determination of patentability is based on the product itself, not by its method of production. *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

Regarding claim 4, the connecting element 1 and the first retaining element 2 comprise complementary welding faces 24 and 22, each provided with fusible ribs 25 and 22, the ribs 25 borne by the welding face 24 of the connecting element 1 being substantially perpendicular to the ribs 22 borne by the welding face 22 of the first retaining element 2.

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Regarding claim 5, the complementary welding faces 24 and 22 are provided on complementary interlocking parts 24 and 22 of the connecting element 1 and the first retaining element 2.

Regarding claim 6, the interlocking part 24 of the first retaining element 2 forms a longitudinal channel 18 (Fig. 5) for the interlocking of the connecting element 1, the welding face 22 of the first retaining element 2 forming a base of the channel 18, the fusible ribs 22 of the first retaining element 2 preferably extending longitudinally.

Regarding claim 7, the complementary interlocking parts 24 and 22 of the connecting element 1 and of the first retaining element 2 comprise fusible complementary welding shoulders 28 and 20 (Fig. 9).

Regarding claim 8, the first retaining element 2 contains two fusible ribs 22 extending longitudinally on either side of the jacket 8 and two fusible welding shoulders 20 extending longitudinally on either side of the jacket 8, the fusible ribs 22 and the fusible welding shoulders 20 of the first retaining element 2 thus being offset laterally with respect to the jacket 8 or, at the very least, with respect to the axis of the jacket 8 as seen in Fig. 2.

Regarding claim 9, the interlocking part 22 of the first retaining element 2 is extended by a shell 12 provided with means 16 for securing it to a fixed support.

Regarding claim 10, the first end of the jacket 8 is its proximal end (8P in Att.).

Regarding claim 11, the proximal end (8P in Att.) of the cable 6 is provided with a block 7 (Fig. 8) for securing this cable 6, the shell 12 forming a housing for this securing block 7.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 2-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel.

Regarding claim 2, Michel teaches the invention substantially as claimed. However, Michel does not teach the process of over-molding of the connecting element 1 on the first end of the jacket 8.

It is common knowledge in the art to overmold Michel's connecting element 1 on the first end of Michel's jacket 8 in order to reduce the cost of manufacturing. The overmolding is notoriously well known as evidenced by the art cited (e.g., see col. 2, line 44+ of US Patent No. 4,321,840 issued to Kalamon, abstract of US Patent No. 6,540,427 B2 issued to Scheidling et al., abstract of EP 1 074 752 A1, and abstract of EP 0 451 411 A1). See also *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to over-mold Michel's connecting element 1 on the first end of Michel's

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jacket 8 in order to reduce the cost of manufacturing as taught or suggested by common knowledge in the art.

Regarding claims 3-9, Michel teaches the invention substantially as claimed. However, Michel does not teach the process of ultrasonically welding of the connecting element 1 to the first retaining element 2.

It is common knowledge in the art to ultrasonically weld Michel's connecting element 1 to the first retaining element 2 in order to reduce the cost of manufacturing. The ultrasonically welding is notoriously well known as evidenced by the art cited (e.g., see col. 2, line 44+ of US Patent No. 4,321,840 issued to Kalamon, abstract of US Patent No. 6,884,941 B2 issued to Birt, abstract of WO 99/10660, and English abstract of JP 56-70119). See also *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to ultrasonically weld Michel's connecting element 1 to Michel's first retaining element 2 in order to reduce the cost of manufacturing as taught or suggested by common knowledge in the art.

18. Claim 12, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable Michel in view of Guidicelli (FR 2 526 506 cited in Applicant's corresponding PCT Application).

Michel teaches the invention substantially as claimed. However, Michel does not teach to form the jacket 8 by at least one wire, *particularly* a metal wire, wound into a spiral with contiguous turns.

Guidicelli teaches to form the jacket by at least one wire, *particularly* a metal wire 7, wound into a spiral with contiguous turns in order to reduce the cost of manufacturing. See *In re Thorpe*, *SmithKline Beecham Corp. v. Apotex Corp.*, and MPEP 2113 *supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Michel's jacket by at least one wire, *particularly* a metal wire, wound into a spiral with contiguous turns in order to reduce the cost of manufacturing as taught or suggested by Guidicelli.

19. Claim 13, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Michel in view of Richard (FR 2 763 983 cited in Applicant's corresponding PCT Application).

Michel teaches the invention substantially as claimed. However, Michel does not teach the module (10) forming a control mechanism arranged in an opening leaf of a motor vehicle, particularly a side door of the vehicle.

Richard teaches the module (10) forming a control mechanism arranged in an opening leaf 22 of a motor vehicle, particularly a side door of the vehicle in order to eliminate freeplay in the device and to tension the cable. See its English abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Michel's module as a control mechanism arranged in an opening leaf of a motor vehicle, particularly a side door of the vehicle in order to eliminate freeplay in the device and to tension the cable as taught or suggested by Richard.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see col. 2, line 44+ of US Patent No. 4,321,840 issued to Kalamon, abstract of US

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Patent No. 6,540,427 B2 issued to Scheidling et al., abstract of EP 1 074 752 A1, abstract of EP 0 451 411 A1, abstract of US Patent No. 6,884,941 B2 issued to Birt, abstract of WO 99/10660, and English abstract of JP 56-70119.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

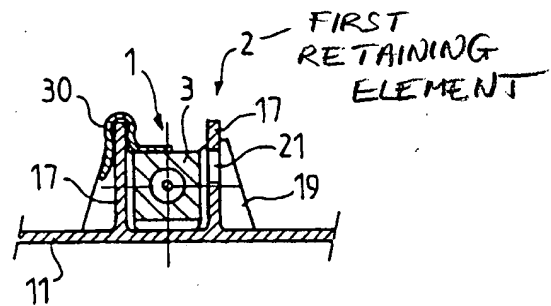
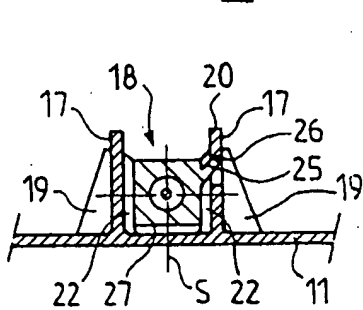
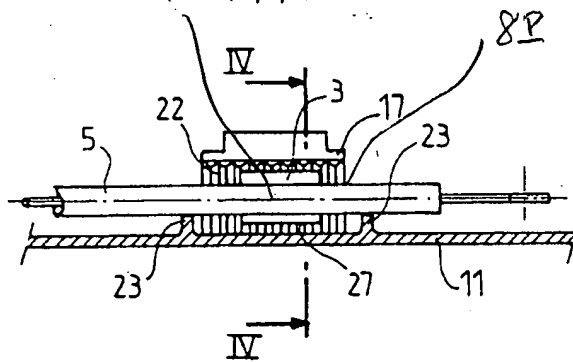
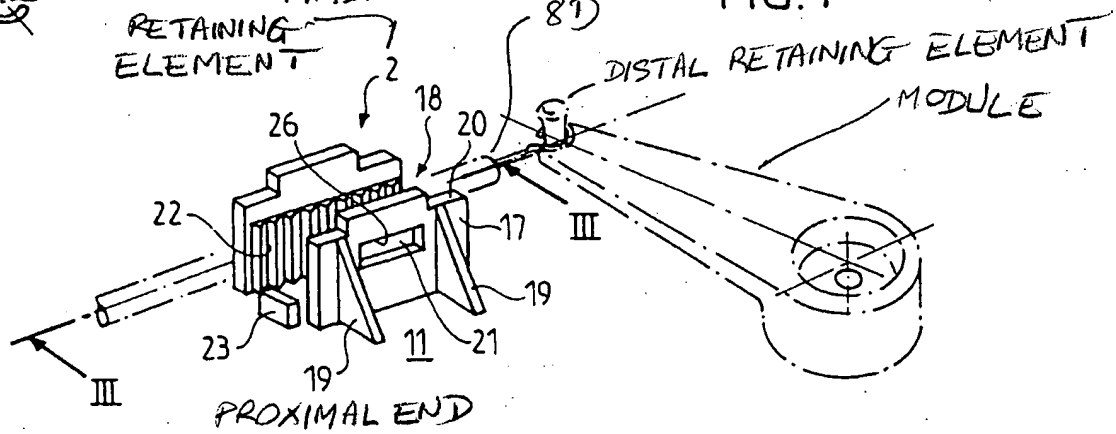
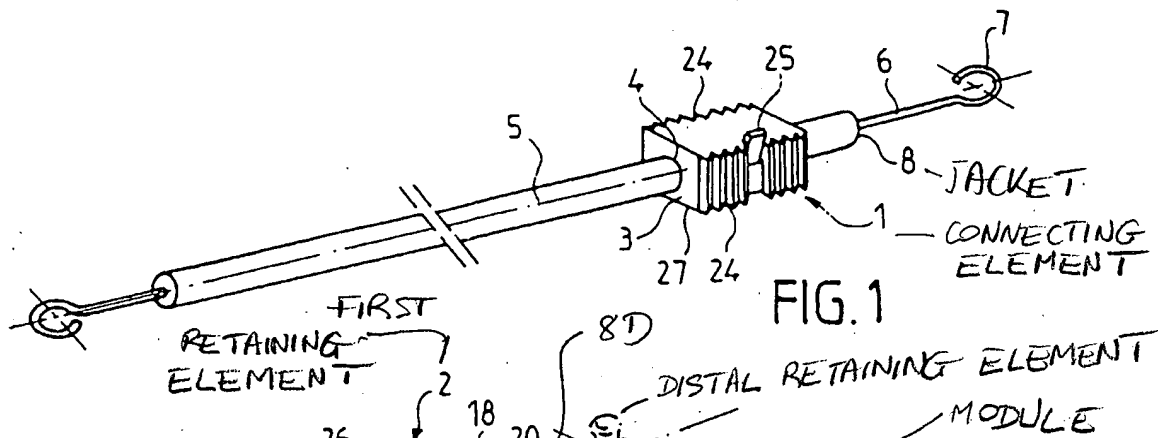
February 5, 2007



Vinh T. Luong
Primary Examiner

ATTACHMENT

1/2



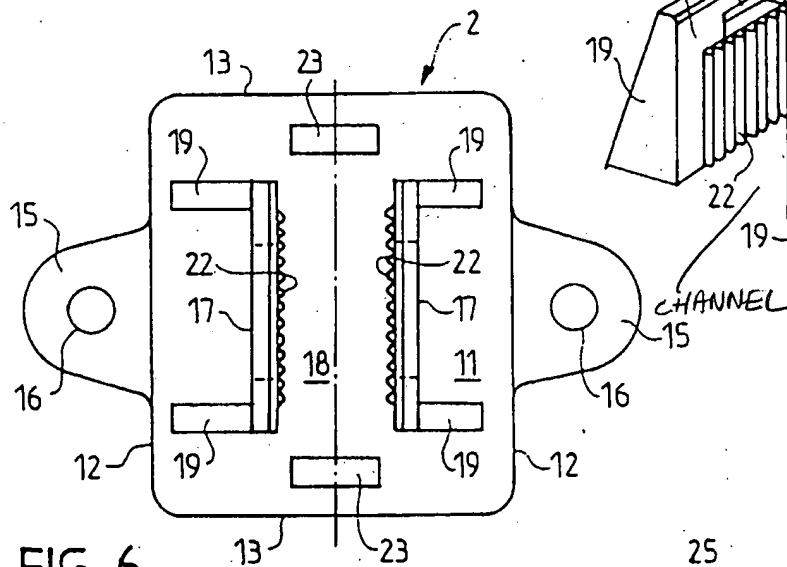
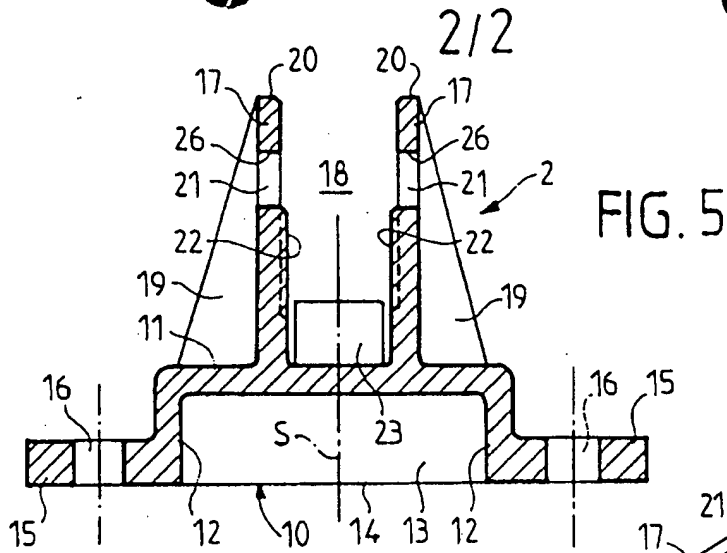


FIG. 6

